

013004

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U.S. PTO

PTO/SB/05 (08-03)

Approved for use through 07/31/2006. OMB 0651-0032

U.S. Patent and Trademark Office. U.S. DEPARTMENT OF COMMERCE

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UTILITY  
PATENT APPLICATION  
TRANSMITTAL

(Only for new nonprovisional applications under 37 CFR 1.53(b))

Attorney Docket No.	97L212A
First Inventor	Boffa
Title	Oil Compositions with Syn
Express Mail Label No.	ET691282693US

## APPLICATION ELEMENTS

See MPEP chapter 600 concerning utility patent application contents.

## ADDRESS TO:

Mail Stop Patent Application  
Commissioner for Patents  
P.O. Box 1450  
Alexandria VA 22313-1450

1. ☒ Fee Transmittal Form (e.g., PTO/SB/17)  
(Submit an original and a duplicate for fee processing)
2. ☐ Applicant claims small entity status.  
See 37 CFR 1.27.
3. ☒ Specification [Total Pages 16]  
(preferred arrangement set forth below)
  - Descriptive title of the invention
  - Cross Reference to Related Applications
  - Statement Regarding Fed sponsored R & D
  - Reference to sequence listing, a table, or a computer program listing appendix
  - Background of the Invention
  - Brief Summary of the Invention
  - Brief Description of the Drawings (if filed)
  - Detailed Description
  - Claim(s)
  - Abstract of the Disclosure
4. ☐ Drawing(s) (35 U.S.C. 113) [Total Sheets \_\_\_\_\_]
5. Oath or Declaration [Total Sheets 9]
  - a. ☐ Newly executed (original or copy)
  - b. ☒ Copy from a prior application (37 CFR 1.63(d))  
(for continuation/divisional with Box 18 completed)
  - i. ☐ **DELETION OF INVENTOR(S)**  
Signed statement attached deleting inventor(s)  
name in the prior application, see 37 CFR 1.63(d)(2) and 1.33(b).
6. ☐ Application Data Sheet. See 37 CFR 1.76

7. ☐ CD-ROM or CD-R in duplicate, large table or Computer Program (Appendix)
8. Nucleotide and/or Amino Acid Sequence Submission (if applicable, all necessary)
  - a. ☐ Computer Readable Form (CRF)
  - b. Specification Sequence Listing on:
    - i. ☐ CD-ROM or CD-R (2 copies); or
    - ii. ☐ Paper
  - c. ☐ Statements verifying identity of above copies

## ACCOMPANYING APPLICATION PARTS

9. ☐ Assignment Papers (cover sheet & document(s))
10. ☐ 37 CFR 3.73(b) Statement of Power of Attorney (when there is an assignee)
11. ☐ English Translation Document (if applicable)
12. ☐ Information Disclosure Statement (IDS)/PTO-1449
13. ☐ Preliminary Amendment
14. ☒ Return Receipt Postcard (MPEP 503)  
(Should be specifically itemized)
15. ☐ Certified Copy of Priority Document(s) (if foreign priority is claimed)
16. ☐ Nonpublication Request under 35 U.S.C. 122 (b)(2)(B)(i). Applicant must attach form PTO/SB/35 or its equivalent.
17. ☐ Other: \_\_\_\_\_

18. If a CONTINUING APPLICATION, check appropriate box, and supply the requisite information below and in the first sentence of the specification following the title, or in an Application Data Sheet under 37 CFR 1.76:

☐ Continuation ☒ Divisional ☐ Continuation-in-part (CIP) of prior application No.: 10/026,549

Prior application information:

Examiner J. HowardArt Unit: 1764

For CONTINUATION OF DIVISIONAL APPS only; The entire disclosure of the prior application, from which an oath or declaration is supplied under Box 5b, is considered a part of the disclosure of the accompanying continuation or divisional application and is hereby incorporated by reference. The incorporation can only be relied upon when a portion has been inadvertently omitted from the submitted application parts.

## 19. CORRESPONDENCE ADDRESS

☐ Customer Number: \_\_\_\_\_ OR ☒ Correspondence address below

Name	Jacob M. Levine				
Address	Infineum USA L.P. 1900 East Linden Ave.				
City	Linden	State	New Jersey	Zip Code	07036
Country	USA	Telephone	908-474-2418	Fax	908-474-2431

Name (Print/Type)	Jacob M. Levine	Registration No. (Attorney/Agent)	32,509
Signature	<i>Jacob M. Levine</i>	Date	1/30/04

This collection of information is required by 37 CFR 1.53(b). The information is required to obtain or retain a benefit by the public which is to file (and by the USPTO to process) an application. Confidentiality is governed by 35 U.S.C. 122 and 37 CFR 1.14. This collection is estimated to take 12 minutes to complete, including gathering, preparing, and submitting the completed application form to the USPTO. Time will vary depending upon the individual case. Any comments on the amount of time you require to complete this form and/or suggestions for reducing this burden, should be sent to the Chief Information Officer, U.S. Patent and Trademark Office, U.S. Department of Commerce, P.O. Box 1450, Alexandria, VA 22313-1450. DO NOT SEND FEES OR COMPLETED FORMS TO THIS ADDRESS. SEND TO: Mail Stop Patent Application, Commissioner for Patents, P.O. Box 1450, Alexandria, VA 22313-1450.

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22141 U.S. PTO  
10/768519

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# FEE TRANSMITTAL

## for FY 2004

Effective 10/01/2003. Patent fees are subject to annual revision.

☐ Applicant claims small entity status. See 37 CFR 1.27

TOTAL AMOUNT OF PAYMENT (\$ 770.00)

**Complete if Known**

Application Number 10/026,549  
 Filing Date January 27, 2004  
 First Named Inventor Boffa  
 Examiner Name J. Howard  
 Art Unit 1764  
 Attorney Docket No. 97L212A

**METHOD OF PAYMENT (check all that apply)**
☐ Check ☐ Credit card ☐ Money Order ☐ Other ☐ None
☒ Deposit Account:
 Deposit Account Number  
 Deposit Account Name

05-1710

Exxon Chemical Co.

The Director is authorized to: (check all that apply)

☒ Charge fee(s) indicated below ☒ Credit any overpayments☒ Charge any additional fee(s) or any underpayment of fee(s)☐ Charge fee(s) indicated below, except for the filing fee to the above-identified deposit account.**FEE CALCULATION****1. BASIC FILING FEE**

Large Entity		Small Entity		Fee Description	Fee Paid
Fee Code	Fee (\$)	Fee Code	Fee (\$)		
1001	770	2001	385	Utility filing fee	770.00
1002	340	2002	170	Design filing fee	
1003	530	2003	265	Plant filing fee	
1004	770	2004	385	Reissue filing fee	
1005	160	2005	80	Provisional filing fee	
SUBTOTAL (1)					(\$ 770.00)

**2. EXTRA CLAIM FEES FOR UTILITY AND REISSUE**

Total Claims	Extra Claims	Fee from below	Fee Paid
3	-20** = 0	X	0.00
1	-3** = 0	X	0.00
Multiple Dependent			

Large Entity		Small Entity		Fee Description
Fee Code	Fee (\$)	Fee Code	Fee (\$)	
1202	18	2202	9	Claims in excess of 20
1201	86	2201	43	Independent claims in excess of 3
1203	290	2203	145	Multiple dependent claim, if not paid
1204	86	2204	43	** Reissue independent claims over original patent
1205	18	2205	9	** Reissue claims in excess of 20 and over original patent

SUBTOTAL (2) (\$ 0.00)

\*\*or number previously paid, if greater; For Reissues, see above

**FEE CALCULATION (continued)****3. ADDITIONAL FEES**

Large Entity Small Entity

Fee Code	Fee (\$)	Fee Code	Fee (\$)	Fee Description	Fee Paid
1051	130	2051	65	Surcharge - late filing fee or oath	
1052	50	2052	25	Surcharge - late provisional filing fee or cover sheet	
1053	130	1053	130	Non-English specification	
1812	2,520	1812	2,520	For filing a request for <i>ex parte</i> reexamination	
1804	920*	1804	920*	Requesting publication of SIR prior to Examiner action	
1805	1,840*	1805	1,840*	Requesting publication of SIR after Examiner action	
1251	110	2251	55	Extension for reply within first month	
1252	420	2252	210	Extension for reply within second month	
1253	950	2253	475	Extension for reply within third month	
1254	1,480	2254	740	Extension for reply within fourth month	
1255	2,010	2255	1,005	Extension for reply within fifth month	
1401	330	2401	165	Notice of Appeal	
1402	330	2402	165	Filing a brief in support of an appeal	
1403	290	2403	145	Request for oral hearing	
1451	1,510	1451	1,510	Petition to institute a public use proceeding	
1452	110	2452	55	Petition to revive - unavoidable	
1453	1,330	2453	665	Petition to revive - unintentional	
1501	1,330	2501	665	Utility issue fee (or reissue)	
1502	480	2502	240	Design issue fee	
1503	640	2503	320	Plant issue fee	
1460	130	1460	130	Petitions to the Commissioner	
1807	50	1807	50	Processing fee under 37 CFR 1.17(q)	
1806	180	1806	180	Submission of Information Disclosure Stmt	
8021	40	8021	40	Recording each patent assignment per property (times number of properties)	
1809	770	2809	385	Filing a submission after final rejection (37 CFR 1.129(a))	
1810	770	2810	385	For each additional invention to be examined (37 CFR 1.129(b))	
1801	770	2801	385	Request for Continued Examination (RCE)	
1802	900	1802	900	Request for expedited examination of a design application	

Other fee (specify)

\*Reduced by Basic Filing Fee Paid

SUBTOTAL (3) (\$)

**SUBMITTED BY**

Name (Print/Type) Jacob M. Levine Registration No. (Attorney/Agent) 32,509 Telephone 908-474-2418  
 Signature *Jacob M. Levine* Date 1/30/04

**WARNING:** Information on this form may become public. Credit card information should not be included on this form. Provide credit card information and authorization on PTO-2038.

This collection of information is required by 37 CFR 1.17 and 1.27. The information is required to obtain or retain a benefit by the public which is to file (and by the USPTO to process) an application. Confidentiality is governed by 35 U.S.C. 122 and 37 CFR 1.14. This collection is estimated to take 12 minutes to complete, including gathering, preparing, and submitting the completed application form to the USPTO. Time will vary depending upon the individual case. Any comments on the amount of time you require to complete this form and/or suggestions for reducing this burden, should be sent to the Chief Information Officer, U.S. Patent and Trademark Office, U.S. Department of Commerce, P.O. Box 1450, Alexandria, VA 22313-1450. DO NOT SEND FEES OR COMPLETED FORMS TO THIS ADDRESS. SEND TO: Commissioner for Patents, P.O. Box 1450, Alexandria, VA 22313-1450.

If you need assistance in completing the form, call 1-800-PTO-9199 and select option 2.

## AMENDMENT TRANSMITTAL FORM

Docket No.: 97L212A )  
 In re ) Before the Examiner  
 Application of: Boffa et al. )  
 Serial No.: 10/026,549 ) **J. Howard**  
 Filed: December 19, 2001 )  
 For: OIL COMPOSITIONS WITH ) Group Art Unit No.  
 SYNTHETIC BASE OILS ) **1764**

Commissioner for Patents  
 P.O. B x 1450  
 Alexandria, VA 22313-1450

Sir:

[ X ] The undersigned hereby certifies having information and a reasonable basis for belief that this correspondence will be deposited as first-class mail with the United States Postal Service in an envelope addressed to the Assistant Commissioner for Patents, Washington, D.C. 20231, on January 30, 2004.

Transmitted herewith is an amendment/response in the above-identified application.

Petition for extension of time pursuant to 37 CFR 1.136 and 1.137 is hereby made if, and to the extent, required. The fee for this extension of time is calculated to be \$\_\_\_\_\_ to extend the time for filing this response until \_\_\_\_\_.

The fee for any changes in number of claims has been calculated as shown below.

CLAIMS AS AMENDED						
(1)	(2) Claims Remaining After Amendment	(3)	(4) Highest No. Previously Paid for	(5) Present Extra	(6) Rate	(7)
Total Claims	15	Minus	20	0	x \$18.00	0.00
Indep. Claims	3	Minus	3	0	x \$88.00	0.00
MULTIPLE DEPENDENT CLAIM FEE					\$290.00	0.00
FEE FOR CLAIM CHANGES						0.00

\* If the entry in Column 2 is less than the entry in Column 4, write "0" in Column 5.

\*\* If the "Highest Number Previously Paid For" IN THIS SPACE is less than 20, write "20" in this space.

\*\*\* If the "Highest Number Previously Paid For" IN THIS SPACE is less than 3, write "3" in this space.

The total fee for this amendment, including claim changes and any extension of time is calculated to be \$ 0.00.


[ ] Charge \$\_\_\_\_\_ to Deposit Account No. 05-1710.

[ X ] The Commissioner is hereby authorized to charge any additional fees which may be required by this paper, or credit any overpayment, to Deposit Account No. 05-1710. A duplicate copy of this Form is enclosed.

January 30, 2004

Date of Signature

Infineum USA L.P.  
 Law Department  
 1900 East Linden Avenue  
 P. O. Box 710  
 Linden, New Jersey 07036-0710

  
 Attorney or Agent

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(For Internal Use Only: Job No. 813,856)

**IN THE UNITED STATES PATENT AND TRADEMARK OFFICE**

APPLICANT:	Boffa et al.	)	
		)	
SERIAL NO.:	10/026,549	)	Examiner: J. Howard
		)	
FILED:	December 19, 2001	)	Art Unit: 1764
		)	
TITLED:	OIL COMPOSITIONS WITH	)	
	SYNTHETIC BASE OILS	)	

Atty. Docket No. 97L212A

Assistant Commissioner for Patents  
Washington, DC 20231

**RESPONSE AFTER FINAL REJECTION**

Sir:

This paper is filed in response to the Office Action mailed December 9, 2003. Reconsideration of the above-identified patent application is requested in view of the following remarks:

The present application is an application for reissue of U.S. Patent No. 6,235,691, issued May 12, 2001. It is again submitted that, in view of the position presented in the Office Action, it is apparent that the present reissue application has not been examined in accordance with applicable rules and procedures. Applicants therefore request that the rejection presented in the Office Action be withdrawn, and that the application be accorded further, proper consideration.

First, applicants wish to acknowledge that the position set forth in the Response mailed March 21, 2003 was incorrect; an error that arose, without deceptive attempt due to reliance on outdated version of 37 CFR 1.176. Applicants apologize for the error, and any confusion said error may have caused.

The present reissue application contains claims 1 through 15. Claims 1 through 11 are identical to claims 1 through 11, respectively, of the original patent. Claims 12 through 15 are directed to a distinct embodiment of the claimed invention, which was clearly disclosed in the specification of the application that matured into the original patent, but was never claimed. The

“error” that applicants are attempting to correct is the failure to claim subject matter that was disclosed, and could have been claimed in the original application, but was not.

The rejection of the reissue application, as it presently stands, is based on the following line of reasoning:

- a) newly presented claims 12 through 15 are directed to an invention that is independent or distinct from the invention described in claims 1 through 11 (the claims of the originally issued patent), and are subject to restriction;
- b) because claims 1 through 11 were prosecuted in the original application, applicants have made a “constructive election of the subject matter of claims 1 through 11 and claims 12 through 15 can therefore be considered withdrawn; and
- c) upon withdrawal of claims 12 through 15, the reissue application becomes identical to the issued patent and that the reissue patent therefore fails to correct any error in the original patent, and is improper (based on an improper oath/declaration).

Issue is not taken with the fact that claims 12 through 15 may be subject to restriction, or that it is proper to consider claims 1 through 11 constructively elected by applicants. However, applicants submit that the withdrawal of claims 12 through 15 does not render the reissue application “improper”. In this regard, applicants point to MPEP Section 1450, which instructs that:

“Claims elected pursuant to a restriction requirement will receive a complete examination on the merits, while the non-elected claims (to any added invention(s)) will be held in abeyance in a withdrawn status, and will only be examined if filed in a divisional reissue application. If the reissue application containing only original unamended claims becomes allowable first (and no “error” under 35 U.S.C. 251 exists), further action in that reissue application will be suspended to await examination in the divisional reissue application(s) containing the added claims. The Office will not allow claims in a reissue application which does not correct any error in the original patent. Once a divisional reissue application containing the added claims is examined and becomes allowable, the examiner will rejoin the two sets of examined and allowed claims into a single reissue application for issuance. Unless applicant requests to the contrary prior to the examiner’s rejoinder of the claims, the claims will be rejoined in the first reissue application (containing the pending original patent claims), and the divisional reissue application will be held abandoned.” (emphasis added)

In view of the above, applicants submit that claims 1 through 11 of the present reissue application must be examined. For the reasons set forth during the prosecution of the original

application, applicants submit that the subject matter of claims 1 through 11 distinguishes over the prior art, and that the reissue application should be allowed. Applicants are, concurrent with the filing of this paper, filing a divisional application claiming the subject matter of withdrawn claims 12 through 15. Assuming that the present reissue application is deemed allowable, said application should then be held in abeyance until the claims of the divisional application are examined and found to contain allowable subject matter, at which point the claims can be rejoined into a single reissue application.

Respectfully submitted,



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